

Application No. 09/221,542
Response Dated April 9, 2004
Reply to Office Action of February 12, 2004

Remarks

This paper is in response to the Office Action mailed February 12, 2004 in connection with the above-identified patent application. In that Action, claims 1-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,208,345 to Sheard, et al. Also, the finality of the October 27, 2003 Office Action was withdrawn, but the February 12, 2004 Action was made final.

A. Rejections Under § 102(e):

Claims 1-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,208,345 to Sheard, et al. ("Sheard"). The Examiner stated that Sheard discloses a computer having a memory and a data storage device coupled thereto that stores data; and one or more computer programs performed by the computer, for selecting a target object in an information catalog and providing information about a source from which the target object was derived.

Applicant has reviewed the filing and issue dates of the Sheard to determine its effective date. That review has lead to a determination that the effective date of Sheard is June 8, 1998. However, the Sheard patent was a continuation-in-part of application serial no. 09/060,667, filed on April 15, 1998. Accordingly, the earliest possible filing date for any of the subject matter contained within the Sheard patent is April 15, 1998.

In view of the effective date of Sheard (June 8, 1998) as well as the earliest possible effective date as to any subject matter contained in Sheard (April 15, 1998), applicant submits herewith a copy of U.S. provisional application serial no. 60/072,550, filed on January 26, 1998 (Appendix A). The instant application claims priority to the '550 provisional application filed in the U.S. well before the earliest possible effective date of the Sheard patent.

It is respectfully submitted that the '550 provisional application sets forth possession of the present invention at least prior to April 15, 1998, which is the earliest possible effective date of any of the subject matter of the Sheard patent. Thus, possession of the present invention antedates Sheard.

Application No. 09/221,542
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It is respectfully submitted that the present application including the claims are supported by the '550 provisional patent application. More particularly, Figures 2, 3, 4, and 6 of the present application are the same as Figures 6, 3, 4, and 2 of the '550 provisional application. In addition, the claims of the instant application are supported by the text and drawing figures of the '550 provisional application. Particularly, the text, drawings and at least page 4 of the '550 provisional application describe a method, article of manufacture, and apparatus of navigating data stored on a data storage device connected to a computer including receiving a user input and, in response to the user input, selecting a target object in an information catalog, and providing information about a source data from which the target object was derived via a transformation performed on said source data to derive said target object.

According to the above comments and arguments presented in combination with the attached copy of the priority '550 provisional application, it is respectfully submitted that Sheard is removed as a reference against the present application. Accordingly, applicant requests that the Examiner remove all rejections under 35 U.S.C. § 102(e) and allow the claims as written.

In addition, applicant does not intend for the filing of this Response to be construed as an admission that Sheard is relevant in any way as a reference against the pending claims or that Sheard discloses the same patentable invention. Accordingly, applicant reserves the right to persuasively argue that the presently claimed subject matter is patentably distinguishable from Sheard.

B. The Finality of the Office Action is Improper:

It is respectfully submitted that the designation of the Office Action mailed on February 12, 2004 as "final" was improper. More particularly, the Examiner stated in the record that

since applicant fails to define the metes and bounds of the claimed subject matter "content of" or "data", which triggers the Examiner making different interpretations based on the new prior art each time when the claims were amended.

However, it is respectfully submitted that the language "content of" as set out in independent claim 1 of applicant's previous Response After Final Rejection filed

*Application No. 09/221,542
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on January 27, 2004 was a typographical error. Applicant respectfully points out that the Amendment D filed on August 5, 2003 canceled the language "contents of" from the independent claims pending in the instant application.

Accordingly, the Examiner should not be confused with regard to the "metes and bounds" of the claimed subject matter "content of" or "data" involved in the claims pending in the instant application.

Clearly, a typographical error was involved with regard to the presentation of the pending claims in the instant application. Further, clearly, applicant's response did necessitate new grounds of rejection.

Accordingly, it is respectfully requested that the finality of the previous Action be withdrawn.

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Conclusion

Applicant respectfully submits that all pending claims are patentably distinct and unobvious over the art of record.

It is respectfully requested that, in the event this Response does not place the application in condition for allowance, the Examiner contact applicant's representative identified below to arrange a telephonic Examiner's Interview to advance prosecution.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

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